



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DW Dec-05

FORTKORT GREETHER + KELTON LLP
9442 N. Capital of Texas Hwy.
Suite 500
AUSTIN TX 78759

COPY MAILED

DEC 01 2005

OFFICE OF PETITIONS

In re Application of :
Emery Randolph Best : LETTER DISMISSING PETITION
Application No. 10/718,170 :
Filed: 20 November, 2003 :
Attorney Docket No.: VYGR001US1 :

This is a communication in response to the petition, filed on 17 October, 2005, under 37 CFR 1.137(b)¹ to revive the above-identified application.

¹ Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

This application became abandoned on 19 December, 2004, for failure to file a timely reply to the Notice to File Missing Parts of Nonprovisional Application, mailed on 18 October, 2004, which set a two (2) month shortened period for reply. Notice of Abandonment was mailed on 15 July, 2005.

On 17 October, 2005, a paper styled as a petition under 37 CFR 1.137(b) was filed by Robert D. McCutcheon, Davis Munck, P.C. on behalf of Edsoft Software Corporation ("ESC").² The petition was accompanied by a statement under 37 CFR 3.73(b) stating that an assignment from the inventors to Voyager Expanded Learning, Inc. ("Voyager") had been previously recorded, but that the present application belonged to ESC by virtue of agreements between Voyager and ESC. The petition is accompanied by a copy of the declaration from the prior application.

On 10 November, 2005, a "Request for Dismissal of Petition to Revive" was filed, signed by registered attorney William N. Hulsey, III, Hulsey IP Intellectual Property Lawyers, P.C., on behalf of assignee Voyager Expanded Learning, Inc., ("Voyager") seeking dismissal of the petition, essentially, on the grounds that ESC does not have sufficient legal interest in the application to control prosecution thereof.

A review of the record reveals that on 20 November, 2003, the above-identified application was filed with an application transmittal sheet listing the present application as a continuation of Application No. 10/124,587, filed on 17 April, 2002 (which issued as U.S. Patent No. 6,676,413 on 13 January, 2004). The assignee of record in the prior application was Voyager. Furthermore, the application papers as filed contained a revocation and power of attorney signed on behalf of Voyager.

There is no showing, however, of either (a) an executed assignment from Voyager to ESC, or (b) an agreement to assign this application from Voyager to ESC.

MPEP 306 states, in pertinent part:

² The petition fee was not filed with the papers received on 17 October, 2005. Assuming, *arguendo*, a petition had been filed by a proper person, the petition would be dismissed because the fee required by law was not received. The PTO will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee. See Krahn v. Comm'r, 15 USPQ2d 1823, 1825 (E.D. Va. 1990).

In the case of a division or continuation application, a prior assignment recorded against the original application is applied >(effective)< to the division or continuation application because the assignment recorded against the original application gives the assignee rights to the subject matter common to both applications. >Although the assignment recorded against an original application is applied to the division or continuation application, the Office's assignment records will only reflect an assignment of a division or continuation application (or any other application) if a request for recordation in compliance with 37 CFR 3.28, accompanied by the required fee (37 CFR 3.41), is filed.<

While no formal 37 CFR 3.73(b) statement was filed on behalf of Voyager, the revocation and power of attorney filed with the application papers may be construed as an assertion of authority to sign on behalf of assignee Voyager. In this regard MPEP 324 states, in pertinent part.

IX. < CONFLICTING 37 CFR 3.73(b) STATEMENTS

Where there are two or more conflicting 37 CFR 3.73(b) statements in an application or other Office proceeding, the statement with the latest date of submission to the Office will normally control as to establishment of the assignee. If, however, the ownership established as controlling is contested on the record by another party who has submitted a conflicting 37 CFR 3.73(b) statement, then the application or other proceeding shall be forwarded by the Office official in charge of the application or other proceeding to the Office of Patent Legal Administration for resolution of the ownership question. >Generally, where there are two or more conflicting 37 CFR 3.73(b) statements in an application, the ownership entity that filed that application will be permitted to conduct the prosecution, and the other party that submitted a 37 CFR 3.73(b) statement to establish its ownership may wish to consider filing an application under 37 CFR 1.47.

(Emphasis added).

As this application was filed as a continuation of Application No. 10/124,587, which was assigned to Voyager, Voyager is

therefore the owner of this application, and as such, is entitled to prosecution control of this application.

With regard to ESC's assertion of ownership of the invention, it is well established that the PTO is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent.³ The USPTO cannot and will not attempt to settle disputes as to title to an application or patent. A judicial tribunal is the appropriate forum to resolve any controversy between ESC and Voyager concerning title to the above-identified application. However, petitioners have presented no evidence that a court of competent jurisdiction has awarded title to the invention to ESC. If petitioner ESC subsequently obtains title to the invention, either by voluntary assignment by the inventor or court order, ESC may execute a power of attorney pursuant to 37 CFR 3.73(b).

The petition filed on 17 October, 2005, on behalf of ESC will not be treated on its merits, but will be retained in the application file.

Petitioner Voyager may file a petition to revive the application in accordance with 37 CFR 1.137(b). An executed oath or declaration and a surcharge for its late filing must accompany any grantable petition under 37 CFR 1.137(b).

Petitioner ESC is further informed that the requested change of correspondence address cannot be made because the attorney signing the request is not an attorney of record. However, should ESC obtain title to the entire interest in the application, as discussed above, ESC may give a power of attorney and change the correspondence address. The assignee must establish its right to take action pursuant to 37 CFR 3.73.

The address listed on the petition is different than the correspondence address of record. A courtesy copy of this decision will be mailed to the address listed on the petition. All future correspondence, however, will be mailed solely to the address of record. If a change of correspondence address is desired, applicants should execute a change of correspondence address form and return it to the USPTO.

³ See, Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924); In re Moller, 1904 Dec. Comm'r Pat. 70, 71 (Comm'r Pat. 1904); Ex parte McTammany, 1900 Dec. Comm'r Pat. 168, 171 (Comm'r Pat. 1900); Ex parte McFarlane, 1896 Dec. Comm'r Pat. 37, 38 (Comm'r Pat. 1896); Ex parte Gallatin, 1892 Dec. Comm'r Pat. 106 (Comm'r Pat. 1892).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

cc: Hulsey IP Intellectual Property Lawyers, P.C.
 1250 S. Capital of Texas Hwy.
 Bldg. 3, Suite 610
 Austin TX 78745

Robert D. McCutcheon
P.O. Drawer 800889
Dallas TX 75380